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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,923	08/07/2001	Richard D. Martin	401-13U1	9008
570	7590	08/07/2006	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			SIDDIQI, MOHAMMAD A	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,923	Applicant(s) MARTIN ET AL.	
	Examiner Mohammad A. Siddiqi	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-24 are presented for examination. Claims 13-24 are examined. Claims 1-12 are restricted.
2. Applicant's arguments, filed on 02/21/2006, with respect to final rejection have been fully considered and are persuasive. The finality of the previous Office action has been withdrawn.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a method of obtaining selected content for a web page, wherein the selected content itself is not initially part of the web page, the web page including script associated with the selected content, classified in class 709, subclass 203.
 - II. Claims 13-24, drawn to a method of syndicating digital assets, classified in class 715, subclass 731.

4. The inventions are distinct, each from the other because of the following reasons:

5. Inventions I - II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as lacking a method of syndicating digital assets, particulars. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Clark A. Jablon on 07/27/2006 a provisional election was made without traverse to prosecute the invention of group II, claims 13-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 are withdrawn from

further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 13, 17 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13, 17

and 21 are non statutory, directed to software, per se, lacking storage on a medium which enables any underlying functionality to occur.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 21 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: means does not correspond to well-defined structure of a computer or computer component implemented in either hardware or software and its associated hardware platform.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

16. Claims 13-24 are rejected under 35 U.S.C. 102(e) as being unpatentable as being anticipated by Pettersen et al (US 6,826, 594) (hereinafter Pettersen).

17. As per claim 13, Pettersen teaches a method of syndicating digital assets comprising:

(a) constructing a web page (fig 2); and
(b) inserting into the web page script associated with at least one digital asset (fig 2, col 4, lines 11-28) that is desired to be part of a fully rendered web page (fig 2), wherein the script, when executed by a browser, requests the content of the digital asset from a remote site (fig 2, col 8, lines 6-30, the request including a uniform resource identifier (URI) of a web page and a unique identifier of the selected content (fig 2, col 8, lines 6-30).

18. As per claim 14, Pettersen teaches the script is JavaScript (fig 2, col 8, lines 6-30).

19. As per claim 15, Pettersen teaches a method of claim 13 wherein the selected content is an executable file (98, fig 2).

20. As per claim 16, Pettersen teaches a method of claim 13 wherein the script includes a subscriber identifier and a content identifier, which together, create the unique identifier of the selected content (col 27, line 15).

21. Claims 17 and 21 do not teach or define any new limitations above claim 13 and therefore are rejected for similar reasons.

22. Claims 18 and 22 do not teach or define any new limitations above claim 12 and therefore are rejected for similar reasons.

23. Claims 19 and 23 do not teach or define any new limitations above claim 15 and therefore are rejected for similar reasons.

24. Claims 20 and 24 do not teach or define any new limitations above claim 16 and therefore are rejected for similar reasons.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent 5,987,525

U.S. Patent 6,484,149

U.S. Patent 6,493,733


U.S. Patent 7,013,340

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS


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